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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92047433
Party	Defendant Jay-Y Enterprise Co., Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

GADO S.R.L.,

Petitioner,

v.

JAY-Y ENTERPRISE CO., INC.,

Respondent.

AND RELATED COUNTERCLAIM.

Cancellation No. 92047433

JAY-Y ENTERPRISE CO., INC.’S EVIDENTIARY OBJECTIONS TO EVIDENCE
OFFERED IN GADO S.R.L.’S PRINCIPAL BRIEF

Respondent Jay-Y Enterprise Co., Inc. (“Jay-Y”) hereby objects to evidence offered by petitioner Gado S.R.L.(“Gado”) in its Principal Brief in support of its Petition for Cancellation. Pursuant to the objections, Jay-Y requests that the evidence be stricken.

Jay-Y’s objections are limited to those portions of the testimony and documentary evidence cited by Gado in its Principal Brief (“Pet. Brf.”). Jay-Y reserves the right to object to any evidence cited by Gado in its Brief as Defendant in the Counterclaim and its Reply Brief as Plaintiff in the Cancellation proceeding.

I. INTRODUCTION

Jay-Y’s objections arise primarily from the fact that Gado’s witnesses, Gabrielle Forte and Paolo Vannucchi, do not have personal knowledge of much of the information to which they testified. The reason for this is readily apparent simply by reviewing their respective associations with Gado.

Ms. Forte, for example, was not employed by Dolce & Gabbana until 2002, well after many of the events at issue in this proceeding occurred. (Forte Depo. 6:6-10.) Similarly, Mr. Vannucchi was not employed by Dolce & Gabbana until 1999. (Vannucchi Depo. 7:16-21.) As a consequence, neither witness has personal knowledge of any of the events that pre-date 1999. This is significant, given that Gado is attempting to prove common law rights to the DG mark that predate Jay-Y's first use in 1993.

In addition to this fundamental flaw with regard to the admissibility of its witness' testimony, Gado also faces insurmountable hurdles with regard to some of its documentary evidence. For example, much of Gado's evidence is based on a 2001 Annual Review, a review that suffers from the same hearsay objection that afflicts annual reviews generally: The factual representations made in an annual report are not admissible for the truth of the matters asserted.

In light of these evidentiary failings, as outlined more fully below, much of Gado's evidence must be stricken.

For ease of reference, these objections are keyed to Gado's Principal Brief and the evidence cited in each section thereof.

II. SPECIFIC OBJECTIONS

A. All Of The Evidence Regarding "The Launch Of Dolce & Gabbana In The United States" (Section II.A) Is Inadmissible Hearsay Or Lacks Foundation

Section II.A of the Principal Brief purports to describe the history of the Dolce & Gabbana line. That history is based almost entirely on Exhibit A (the 2001 Annual Review) and the testimony of Ms. Forte.

With regard to the Annual Review, Gado is relying on statements reflected in the Review regarding the purported renown of the Dolce & Gabbana brand and the history of the company. See, e.g., Pet. Brf. 5 (citing to Exhibit A, DG00582 ("Dolce & Gabbana ... is now one of the

leading international merchandise groups”) and Exhibit A, DG00588 (“The two founders opened their first studio in 1982 ...”); Pet Brf. at 7 (citing to Exhibit A, DG00589 (purported timeline of Dolce & Gabbana)). Because these statements are being presented for the truth of the matters asserted, they are inadmissible hearsay. *See Research in Motion Limited v. Fashionberry, Inc.*, Opp. No. 91191572 (TTAB Sept. 30, 2011) (non-precedential) (“the statements contained in the annual report are hearsay, and not admissible for opposer’s purpose. The annual report is of record only for what it shows on its face; it is not admissible for the truth of any matters stated therein, such as opposer’s sales figures”), citing *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 12 USPQ2d 1267, 1270 n.5 (TTAB 1989) (annual report in evidence only for what it showed on its face), *aff’d*, 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990); *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1717 n.2 (TTAB 2007) (materials made of record by notice of reliance under 37 CFR §2.122(e) not admissible for the truth of the matters contained therein, unless a competent witness has testified to the truth of such matters).

Moreover, Ms. Forte’s testimony does not salvage the Annual Review. Her testimony regarding the early history of the company is entirely hearsay and lacks foundation. Fed. R. Evid. 601, 602, 801, 802; *see, e.g.*, Forte Depo. 30:23-31:6 (she knows when the line was founded because she was present at a 20th anniversary event in 2005); 31:7-32:3 (her testimony regarding the early history of the company lacks foundation and is hearsay); 32:4-34:17 (she knows about the early history because “I spoke to all the journalists” and “I remember very specifically Mr. Fairchild telling me”).

With regard to the articles cited in this section of the Principal Brief – NOR Exhibits 50, 52, 53, 54, 78 and 83 – they are only admissible for what they show on their face, but not for the truth of the matters stated therein. *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d

1112, 1117 n.7 (TTAB 2009) (printed publications probative only for what they show on their face, not for the truth of the matters contained therein, unless a competent witness has testified to the truth of such matters). As a result, Ms. Forte’s statement that “Dolce & Gabbana ultimately provided more than 1,500 pieces of costume for Madonna” and Madonna’s purported relationship with the company (Pet. Brf. at 6) is inadmissible hearsay.

B. The Evidence Regarding The Adoption Of The DOLCE & GABBANA Mark (Section II.B.1) Is Inadmissible Hearsay And Lacks Foundation

As support for the statement that Gado “employed its eponymous DOLCE & GABBANA mark since ... 1985,” Gado cites the bare testimony of Ms. Forte, who was not employed by the company until 2002. As discussed above, her testimony – Forte Depo. 31:7-32:21 – lacks foundation and is inadmissible hearsay.

C. The Evidence Regarding The Adoption Of The D&G DOLCE & GABBANA Mark (Section II.B.2) Is Inadmissible Hearsay And Lacks Foundation

As support for the statement that Gado “launched its ‘younger’ D&G DOLCE & GABBANA collection in 1994” Gado cites to the 2001 Annual Review. As discussed above, absent competent testimony to attest to the contents of the Annual Review, the statements contained therein cannot be admitted for the truth of the matters asserted. Because neither of Gado’s witnesses was employed by Gado in 1994, neither could attest to the veracity of the statement in the Annual Review. The evidence, therefore should be stricken.

Moreover, Gado’s statements regarding the purported “first New York show for its ‘D&G’ line” (Pet. Brf. 7) and the launch of its eyewear are not supported by competent testimony. The cited portion of Ms. Forte’s testimony exemplifies the fact that vast majority of Gado’s evidence lacks foundation. Specifically, Ms. Forte testified as follows:

- Q. Did there come a time when you actually saw the D&G mark affixed to any goods in the marketplace?
- A. Yeah, I saw it, and I can't remember now the year, but I do remember – it could have been '95, '96, '97, it's around that time. They did a D&G show in New York at the tents. I know they called me and they wanted me to go and bring Calvin and his wife Kelly. I was in the middle of market. We had a big financial meeting. *I couldn't go*, but Calvin went because he really liked them. He was very supportive of them. He went to this D&G show that they had at the tents during fashion week here in New York.

(Forte Depo. 41:15-42:5.) In other words, Ms. Forte did not even attend the show at which the D&G DOLCE & GABBANA mark purportedly was first used. Moreover, after Jay-Y's counsel objected to the testimony, Ms. Forte testified as follows:

- Q. Did you, yourself, see the mark affixed to clothing at about that time?
- A. I'm sure I did, whether it was in Italy or here, yeah.
- Q. Do you know where that was? I mean, was it in a store, was it in an advertisement?
- A. Okay, store, let me look. I can't remember the store. Advertisement, I did tell you that I saw it in an advertisement.

(Forte Depo. 42:9-18.) Thus, viewed in its totality, Ms. Forte testified that she could not recall when the D&G DOLCE & GABBANA mark was first adopted, that it was displayed at a show she did not attend, that she could not recall where she first saw the mark, and that she thought she saw it in an advertisement and not on goods. There is no evidentiary support for Gado's statement that "Dolce & Gabbana's New York shows for the 'D&G Dolce & Gabbana' line prominently featured the 'D&G' initials for the company's designers." (Pet. Brf. at 7.)

Even the testimony regarding when Gado opened its first retail outlet in the United States under the D&G DOLCE & GABBANA mark lacks foundation. Mr. Vannucchi, who started

working for the company in 1999, testified that the first outlet opened in 1997. (Vannucchi Depo. 25:10-18.) His testimony lacks foundation and should be stricken.

D. The Evidence Regarding The Adoption Of The DG Mark (Section II.B.3) Is Inadmissible Hearsay And Lacks Foundation

Similar to the testimony regarding the other marks at issue, Gado's evidence regarding the adoption of the DG mark lacks foundation. While Ms. Forte testified that the mark *currently* is being used on a wide variety of goods (Forte Depo. 24:9-25:25) her testimony regarding when it was first adopted is far less clear. For example, Ms. Forte testified that "As I told you, 1994, I remember the DG bag because of this designer that I hired for the accessories line. *Actually, it was 1995.*" (Forte Depo. 83:6-8.) In addition, Ms. Forte could not testify whether the bag was even sold in the United States:

Q. Do you know whether that bag available for sale in the United States?

A. Specifically, I don't know that.

(Forte Depo. 161:7-10.) There thus is no support for the Gado's characterization of her testimony as "regarding 'DG' on purse in runway shows in 1994." (Pet. Brf. at 7.) That evidence should be stricken.

E. The Evidence Regarding The Alleged Use Of Initials As Marks By Third Parties (Section III.B.2) Is Inadmissible Hearsay

Citing to the bare testimony of Ms. Forte, Gado asserts that it is customary for "high-end fashion designers such as Calvin Klein, Giorgio Armani and CoCo Chanel" to use initials as marks. (Pet. Brf. 25 *citing* Forte Depo. 60:21-66:13.) Ms. Forte's testimony is plainly hearsay, in that it is being presented for the truth of the matter asserted, namely that other fashion designers behave in a certain manner. As a result, her testimony should be stricken, and this argument ignored.

III. CONCLUSION

For the foregoing reasons, Jay-Y respectfully requests that the Board strike the cited testimony of Ms. Forte and Mr. Vannucchi, and find that the propositions supported by that testimony are unsupported.

SEYFARTH SHAW LLP

Dated: October 31, 2011

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CERTIFICATE OF SERVICE

I hereby certify that on October 31, 2011, I served the foregoing JAY-Y ENTERPRISE CO., INC.'S EVIDENTIARY OBJECTIONS TO EVIDENCE OFFERED IN GADO S.R.L.'S PRINCIPAL BRIEF on the Petitioner by depositing a true copy thereof in a sealed envelope, postage prepaid, in First Class U.S. mail addressed to Petitioner's counsel as follows:

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/s/ Kenneth L. Wilton

Kenneth L. Wilton